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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,724	01/27/2004	Masashi Takubo	2271/71526	3447
7590	01/25/2007		EXAMINER	
Ivan S. Kavrukov, Esq. Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			WASHINGTON, JAMARES	
			ART UNIT	PAPER NUMBER
			2609	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/766,724	TAKUBO, MASASHI
	Examiner	Art Unit
	Jamares Washington	2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-19 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Attached.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

5/8/6; 8/12/4; 1/27/41

JW

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

The following title is suggested: Method and Apparatus for Reliable and Secure Facsimile Communications using dual memory storage. Current title is quite lengthy and too descriptive of the subject matter. An appropriate modification is suggested.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. *O'Reilly*, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in Sec. 101.

Claims 11, 14, and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 11, 14, and 17 Takubo defines a “program storage device readable by the computer system” embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory. (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). The scope of the claimed invention is much broader than simply claiming a “computer readable medium” and will therefore encompass non-statutory subject matter.

Claims 13, 16, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 13, 16, and 19 Takubo defines a computer data “signal” with descriptive material. While “functional descriptive material” may be claimed as a statutory product when embodied on a tangible computer readable medium, a “signal” embodying functional descriptive material is neither a process nor a product (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory classes of § 101. Rather, a “signal” is a form of energy, in the absence of any physical structure or tangible material.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshiaki Ozeki (JP 11-239238 A). A machine translation of JP 11-239238 A, provided herewith, is being relied upon for the time being. A formal translation is on order, and will be provided with the mailing of the next Office Action.

Regarding claim 1, Ozeki discloses a facsimile communications mechanism configured to perform a facsimile communications operation (“This invention relates to the facsimile

apparatus for confident document reception which can receive and peruse the document which was applied to facsimile apparatus..." at paragraph [1]); a first storage mechanism configured to store data and to be inaccessible through the local area network ("...the storage section 12 which has the judgment function by the central processing unit (CPU), and holds document data..." paragraph [20]); a second storage mechanism configured to store data and to be accessible through the local area network ("There is an individual box (BOX) 121 which is the storage region of the dedication for every..." and "...since the usual document which is not confidential...is stored in the storage section 12, there is "a" share BOX 122 which anyone can peruse..." at paragraph [23]. Both BOXES 121 and 122 are attached to the main storage and, depending on whether the document stored is confidential, it will store the document in the respective box. ); a backup arranging mechanism configured to store received document data into the first storage mechanism and to store a copy of the received document data into the second storage mechanism ("The storage section 12 stores the document data received at step 46 mentioned above to the individual BOX of the ID among individuals" or when it is not confidential "...the storage section 12 stores the document data received at step 46 mentioned above as reception of the usual document to the share BOX 122..." at paragraph [32]; a determining mechanism configured to determine whether the received document data is confidential ("The storage data which has a judgment function receives ID acquired by the transmission control unit 11 in facsimile apparatus 10 on the other hand when it was confidential reception, Relevance ID is searched and it is confirmed whether the applicable individual BOX exists." at paragraph [32]); a control mechanism configured to cause the backup arranging mechanism to cancel storing a copy of the received document data into the second storage

mechanism when the received document data is determined as confidential by the determining mechanism (“The storage section 12 stores the document data received at step 46 mentioned above to the individual BOX of the ID among individuals BOX 121, when Relevance ID exists as a result of retrieval” at paragraph [32] as opposed to being stored in the publicly accessible BOX 122. One of ordinary skill in the art would construe this as “canceling” the storage of the document into the “second storage mechanism” (BOX 122) because the document was deemed confidential.)

Regarding claim 2, Ozeki discloses a facsimile communications mechanism configured to perform a facsimile communications operation; a first storage mechanism configured to store data and to be inaccessible through the local area network; a second storage mechanism configured to store data and to be accessible through the local area network; a backup arranging mechanism configured to store received document data into the first storage mechanism and to store a copy of the received document data in the second storage mechanism (as rejected in claim 1 above); a determining mechanism configured to determine whether the received document data stored in the second storage mechanism is confidential upon a receipt of a data transmission request for transmitting the received document data stored in the second storage mechanism from an external terminal through the local area network (“First, if an electronic mail 32 is received, a personal computer 20 will perform a browser by the client control section 22, and will access the facsimile apparatus...”(request transmission of confidential document) at paragraph [36]. “...in response, the client control section 22 notifies ID and a password to the Web server (facsimile apparatus acting as a web server) control section 13 that the user of a

personal computer 20 enters ID and a password from the input section 24 through a network 30..." (e.g. determination has been made that document data requested is confidential from entering of ID and password) at paragraph [37]); and a control mechanism configured to refuse the data transmission request from the external terminal through the local area network when the received document data is determined as confidential by the determining mechanism ("The storage section 12 notifies the link to the individual BOX of the ID to the web server control section 13, when corresponding ID and the password are searched and there are applicable data. (This would imply that if the ID and password did not correspond with the requested link, the storage section will "refuse data transmission" to the external terminal (PC)) at paragraph [38]).

Regarding claim 3, Ozeki discloses the facsimile apparatus of claim 2 rejection above using a "web browser" as the external terminal ("This invention relates to the facsimile apparatus for confidential document reception which can receive and peruse the document which was applied to facsimile apparatus, especially reached the individual as confidential from the personal computer (it abbreviates to a personal computer hereafter) using the browser which can peruse World Wide Web (WWW)..." at paragraph [1]).

Regarding claim 4, Ozeki discloses the facsimile apparatus comprising communication means, first and second storage means, backup arranging means, determining means, and control means, which is defined by the specification as being the facsimile communications mechanism, the first and second storage mechanisms, the backup arranging mechanism, the determining mechanism, and the control mechanism respectively, as rejected in claim 1 above.

Regarding claim 5, Ozeki discloses the facsimile apparatus as rejected in claim 2 above.

Regarding claim 6, Ozeki discloses the facsimile apparatus and web server means as rejected in claim 3 above.

Regarding claim 7, Ozeki discloses a communications method for a facsimile apparatus as rejected in claim 1 above.

Regarding claim 8, Ozeki discloses a communications method for a facsimile apparatus as rejected in claim 2 above.

Regarding claim 9, Ozeki discloses a communications method for a facsimile apparatus as rejected in claim 3 above.

Regarding claim 10, Ozeki discloses a computer readable data recording medium storing a program which causes a computer to execute operations according to a communications method as rejected in claim 3 above (“Usually, since the function as a server is needed in order to transmit the document received to the facsimile apparatus side to a personal computer when doing such a thing, a server’s software is needed...” at paragraph [4]. “...the storage section 12 which has the judgment function by the central processing unit (CPU)...” at paragraph [20]. This would imply that the CPU holds the program used to discern the confidentiality of a

received document and the software needed to cause the facsimile apparatus to function as a web server, therefore allowing the facsimile method of claim 8 to commence).

Regarding claims 11, 14, and 17, Ozeki discloses the program storage device (CPU) as rejected in claim 10, readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method claimed and rejected in claims 7, 8, and 9 respectively.

Regarding claims 12, 15, and 18, Ozeki discloses a computer system (networked facsimile apparatus with external computer(s)) comprising the program storage device as rejected in claims 11, 14, and 17 respectively.

Regarding claims 13, 16, and 19, Ozeki discloses a computer data signal transmitted in one or more segments in a transmission medium. The method carried out (and rejected) in claims 7, 8, and 9 respectively is constructed using a facsimile apparatus and memory storage. It would have been well known to a person of ordinary skill in the art at the time the invention was made that communication done through integrated circuitry relating to computer devices (i.e. facsimile apparatus and memory chips) is carried out through the transmission of "signals" to interconnected devices. Therefore, since the facsimile apparatus disclosed by Ozeki is deemed operative, signals are transferred to the CPU in order for the structure to carry out the method of claims 7, 8, and 9.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamar Washington whose telephone number is (571) 270-1585. The examiner can normally be reached on Monday thru Friday: 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on (571) 272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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